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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/421,629	10/19/1999	JAY M. SHORT	DIVER1260-3	4408

7590

12/24/2003

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EXAMINER

NASHED, NASHAAT T

ART UNIT

PAPER NUMBER

1652

DATE MAILED: 12/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

S.M.

Office Action Summary

Application No.

09/421,629

Applicant(s)

SHORT ET AL.

Examiner

Nashaat T. Nashed

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 48-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 48-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

The application has been amended as requested in the communication filed September 29, 2003.

Claims 48-63 are pending and under consideration.

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because it contains improper claimed priority information. Specifically, it claims priority to serial number 09/089,789 filed June 3, 1998, which is a CIP of serial number 09/034,724, filed March 4, 1998, which is a CIP of 08/665,565 filed June 18, 1996.

Applicant filing of unexecuted declaration is noted. The objection to the declaration will remain of record until applicant perfect his declaration.

Claims 50 and 51 are objected to under 37 CFR § 1.75(d)(1) as being in improper form because the claim states an improper Markush group. Compounds included within a Markush group must "(1) share a common utility and (2) share a substantial structural feature disclosed as being essential to that utility." (See MPEP § 803.02.) The enzymes in claims 50 and 51 do not share common structure or function, and therefor, the Markush group is improper for the reasons set forth in the prior Office action mailed May 27, 2003.

Applicants argue that amendment of the claim to remove the phrase "selected from the group consisting of" obviate the above objection.

Applicants' arguments filed 9/29/03 have been fully considered but they are not deemed to be persuasive. There are several forms of Markush group claims. Replacing one form of a Markush group by another does not obviate the objection.

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 48-63 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was

filed, had possession of the claimed invention for the reasons set forth in the prior Office action mailed May 27, 2003.

Applicants amended the claims to limit the claimed molecules to a protein and argue that disclosure has fully described the claimed invention.

Applicants' arguments filed 9/29/03 have been fully considered but they are not deemed to be persuasive. The examiner disagrees. The specification describes and enables a method of identifying a protein or nucleic acid of interest, but it does not even describe a single protein or nucleic acid of interest, i. e., a product of the method, let alone, any protein produced by said method.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 48-63 are rejected under 35 U.S.C. § 102(b) as being anticipated by the commercial availability of numerous commercial enzymes such as subtilisines, lipases, protein kinases, oxidases and glucosidases as well as the nucleic acids sequences, proteins, peptides and enzymes known in commercial databases, for the reasons set forth in the prior Office action mailed May 27, 2003.

Applicants cited the Circuit Court decision in *Atlantic Thermoplastic Co. v. Faytex Corp.*, the top three lines of page 9, and argue that since the process of obtaining a protein is new, the product of the method is new and therefore is patentable.

Applicants' arguments filed 9/29/03 have been fully considered but they are not deemed to be persuasive. As indicated in the prior Office action, the patentability of the product of a method resides in the product itself and not the method by which it is made or identified. This concept is clearly supported in *Atlantic Thermoplastic Co. v. Faytex Corp.* through out the decision by the court, see for example pages 1487, second paragraph through the end of the second paragraph on page 1492. The claimed protein invention is a chemical compound that is not described in the specification by any physical or chemical properties, and therefore can not be distinguished from a commercially available proteins and enzymes.

No claim is allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nashaat T. Nashed, Ph. D. whose telephone number is (703) 305-6586. The examiner can normally be reached Monday, Tuesday, Thursday, and Friday from 9:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, can be reached on (703) 308-3804. The fax phone numbers for this Group are (703) 305-3014 and (703)308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Nashaat T. Nashed, Ph. D.
Primary Examiner